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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,534	12/19/2003	Brett Rimmer	56.0719	1533
27452	7590	11/29/2007		
SCHLUMBERGER TECHNOLOGY CORPORATION			EXAMINER	
David Cate			FIGUEROA, JOHN J	
IP DEPT., WELL STIMULATION				
110 SCHLUMBERGER DRIVE, MD1			ART UNIT	
SUGAR LAND, TX 77478			PAPER NUMBER	
			1796	
			NOTIFICATION DATE	
			DELIVERY MODE	
			11/29/2007	
			ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/707,534	RIMMER ET AL.	
	Examiner	Art Unit	
	John J. Figueroa	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. Receipt is acknowledged of a request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e) and a submission (amendment), filed on September 14, 2007. The request has been deemed proper and this application has been hereby examined in view of said amendment.
2. Examiner regrets the typographical error wherein both "Final" and "Non-Final" boxes in the Office Action Summary Sheet submitted with the Office Action of May 14, 2007. However, item 16 on page 11 of the body of the office action itself explicitly states that the action was "Final" as was the entry of this action as a "Final Rejection" on the public PAIR system.

Response to Amendment

3. The 35 U.S.C. 103(a) rejection of claims 1, 3-5, 7-12 and 16 (item 3 on page 2 of the Final Office Action, hereinafter 'FOA') as unpatentable over United States Patent Number (USPN) 4,846,279 to Bruce (hereinafter 'Bruce') in view of USPN 4,790,386 to Johnson (hereinafter 'Johnson') has been maintained for reasons previously made of record in items 3 and 9 on pages 2 and 4, respectively, of FOA. Examiner notes that the limitations in claim 16 were previously presented in claim 8 and thereby addressed in this rejection.

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4. The 35 U.S.C. 103(a) rejection of claims 1, 13-15 and 17 as unpatentable over USPN 6,387,986 B1 to Moradi-Araghi, hereinafter 'Moradi' in view of Bruce and Johnson (as applied in paragraph #3 above) has been maintained for reasons previously made of record in item 5 on page 2 of FOA. Examiner notes that limitations in claim 17 were previously presented in claim 13 and thereby addressed in this rejection.

5. The 35 U.S.C. 112, first paragraph, rejection of claims 1 and 3-15 (and 16 and 17 that depend therefrom) has been maintained for reasons previously made of record in item 7 on page 3 of FOA and for reasons set forth below in paragraph #7 of the instant Action.

6. The 35 U.S.C. 103(a) rejection of claims 4, 6, 7 and 9 as unpatentable over Bruce in view of Johnson, as applied to claims 1 and 4 above in paragraph #3 of the instant Office Action, and further in view of USPN 3,104,716 to Burkhardt et al. (hereinafter 'Burkhardt'), has been maintained for reasons previously made of record in item 10 on page 5 of FOA.

Response to Arguments

The 35 U.S.C. 112, First Paragraph, Rejection (item 7 on page 3 of FOA)

7. Applicant's arguments filed regarding the captioned 35 U.S.C. 112, first paragraph, rejection of claims 1 and 3-17 have been fully considered but deemed unpersuasive.

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Applicant's arguments traversing this rejection are primarily based upon paragraph [0020] of the present specification (filed December 19, 2003) providing support for the term "generally non-degradable". Particularly, Applicant argues that the disclosure in paragraph [0020] stating that the "enclosure may consist of any polymer that can degrade over a period of time" provides support for the term "generally non-degradable". If anything, this disclosure in the specification may provide support for a *degradable* container that "degrade[s] over a period of time", but not for a container that is "*generally non-degradable*" in the production fluids as recited in independent claim 1.

For example, an express definition in a specification of the terms "alkyl substituent", "polymer container" and "production fluids" by themselves may not provide support for terms such as "generally non-alkyl substituent", "generally non-polymer container" and "generally non-production fluids", respectively, due to, *inter alia*, equivalents that may overlap both sets of terms. It is confusing as to how a disclosure of a *degrading* container that degrades over a period of time provides written description support for a "*generally non-degrading* container".

In addition, wouldn't all polymeric disclosures degrade "over a period of *time*" (given enough length of time)? It is further uncertain from the specification and the claims as to what exactly is a *generally non-degradable* container and as to which materials do *not generally* degrade after a period of time.

Accordingly, claims 1 and 3-17 remain rejection under 35 U.S.C. 112, first paragraph, as having new matter without sufficient written description support in the specification.

The 35 U.S.C. 103 Rejection over Bruce and Johnson (item 3 and 9 on pages 2 and 4 of FOA)

8. Applicant's arguments filed regarding the 35 U.S.C. 103(a) rejection of claims 1, 3-5, 7-12 and 16 as unpatentable over Bruce in view of Johnson have been fully considered but deemed unpersuasive.

Applicant's arguments that Bruce's container with apertures having the screen cover taught by Johnson does not meet the claim's "meshed or mesh-like container" limitation because the container in Bruce is "formed from cylinder walls" is misdirectional. First, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The instant rejection is a 35 U.S.C. 103 obviousness rejection over Bruce **and** Johnson, not a rejection over Bruce alone. Bruce discloses a container that is "generally non-degradable" with apertures not significantly impeding the flow of production fluids, whereas Johnson (as discussed in item 13 of FOA) teaches that an open mesh screen can be added to an opening of a container (such as having *at least one* aperture, which can be several, as in the canister used in Bruce's method of treating a well bore) that can restrain a treatment composition, thereby providing an enhanced resultant method of treatment delivering various types of scale/corrosion inhibitor chemicals to the side walls of the production tubing of a well bore. Accordingly, it is unclear as to why the container of Bruce and Johnson is **not**

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mesh-like if the resultant container has apertures and a meshed-screen and does not ***significantly*** impede the path of production fluids.

See the following from item 13 of FOA:

"Bruce discloses treating a well bore by locating a canister at the bottom portion of a well bore, said canister (container) having a bladder that includes a chemical treating composition that flows into the production fluid by pressure differentiation, wherein the flow rate of delivery of the composition into the well can be controlled and predetermined. (Abstract; Figures 1 and 2; col. 2, lines 18-30 and 42-54) The canister ... can be ... made from stainless steel, titanium or similar materials that can withstand the physical stresses to which it is exposed and resist attack from corrosive well fluids (so that it can be reused) and thus perform satisfactorily during its entire design life. (Col. 2, lines 51-54; Col. 3, lines 4-40; col. 4, lines 40-59) ... Bruce further discloses *that the bottom of the canister may contain at least one aperture, on its bottom wall or on its side, through which the well fluid can enter thereby*, subjecting the inner bladder to the fluid pressure existing at the bottom portion of the well. (Col. 3, lines 41-62) The flow rate *can also be* severely restricted allowing for the canister to be located at a higher point in the well bore and thus, anchored alongside the sidewall of the well bore. (Col. 4, lines 60 to col. 5, line 2; col. 5, line 55 to col. 6, line 25; Fig. 2)" [Pages 6 and 7 of OA; Emphasis Added]

Consequently, as discussed in FOA, Bruce is expressly disclosing that the container can have several apertures through which the production fluids of the well can enter, thereby not "significantly" impeding the flow of production fluids through the container.

Thus, claims 1, 3-5, 7-12 and 16, as amended, remain unpatentable over Bruce and Johnson.

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The 35 U.S.C. 103 Rejection over Bruce, Burkhardt and Johnson (item 10 on page 5 of FOA)

9. Applicant's arguments filed regarding the 35 U.S.C. 103(a) rejection of claims 4, 6, 7 and 9 over Bruce and Johnson and further in view of Burkhardt have been fully considered but deemed unpersuasive.

Applicant's principal argument traversing this rejection is that the combination of Bruce and Johnson do not teach a mesh-like container. However, this issue was addressed above in the immediately preceding paragraph where it was shown that the container of Bruce and Johnson, in combination, suggest a "mesh-like" container.

Thus, the instant claims, as amended, remain unpatentable over Bruce, Johnson and Burkhardt.

The 35 U.S.C. 103 Rejection over Moradi, Bruce and Johnson (item 5 on page 2 of FOA)

10. Applicant's arguments filed regarding the 35 U.S.C. 103(a) rejection of claims 1, 13-15 and 17 over Moradi in view of Bruce and Johnson have been fully considered but deemed unpersuasive.

Examiner notes that Applicant did not address in Response the particular grounds of rejection regarding Moradi, Bruce and Johnson except to mention on page 9 that Moradi-Araghi does not disclose a method of delivering a composition into a well bore and "fails to provide a "meshed or mesh-like container". However, Moradi was not cited for this purpose but for showing that the container of Bruce and Johnson can be

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used to deliver well bore treatment compositions having encapsulated chemical/polymers using a *meshed* or *mesh-like* container.

As shown above in the instant Action regarding the grounds of rejection of Bruce in view of Johnson (paragraph #8), this combination does obviate, *inter alia*, the meshed or meshed-like limitations of the instant rejected claims, as amended. Moradi discloses encapsulating crosslinking agents and gel-forming chemicals to be used in oil-field compositions. (Page 10, lines 7-8) Bruce and Johnson teach an effective method of delivering oil-filed chemical compositions into a well bore over a preferred, extended period of time. Accordingly, as explained in item 5 of FOA, it would have been obvious to one in the art to provide the encapsulated chemical treatment compositions disclosed in Moradi into a production casing of a well bore using the efficient delivery system taught by Bruce and Johnson.

Thus, claims 13-15 and 17 remain unpatentable over Moradi in view of Bruce and Johnson.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Figueroa whose telephone number is (571) 272-8916. The examiner can normally be reached on Monday-Thursday 8:00-6:00pm.

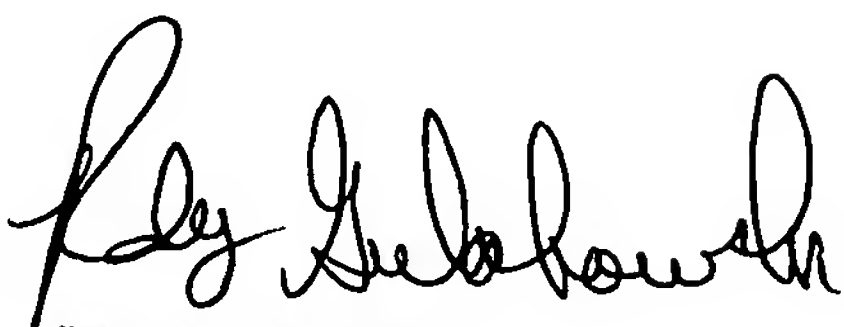
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JJF/RAG


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